

U.S. SN 09/554 674
October 14, 2003
Page 13

REMARKS

Claim 24 was rejected as being unpatentable over Smith in view of Froessl et al. It was acknowledged that Smith failed to teach repeatedly and automatically reviewing the content of output documents to identify content that is repeatedly used and which can be replaced by a shorter access code, thereby reducing the volume of unique data to be added to the output documents. Froessl was said to teach that function, referring to Fig. 2 and col. 7 to col. 8, line 25 of Froessl.

The cited Froessl patent teaches no such thing. Fig. 2 shows a table of various fonts which can be dealt with by the system. That figure has nothing to do with recognizing or replacing repeatedly used text by a shorter access code.

Col. 7 and col. 8 of Froessl discuss nothing at all related to replacing used text by a shorter code. The first part of col. 7 describes locating addressee information, notifying an addressee of the existence of a message, converting text (as in OCR), and choosing search words for future use. Beginning at about line 45 of col. 7, the font table is discussed in some detail, especially concerning the identifying of "slots" for storage of unique font information. There is no mention or suggestion of anything like the subject matter of the language quoted in the Action.

The assertion of "obviousness" in the Action comprises a recitation of one advantage of the system of the present invention, but that advantage cannot be said to be obvious since the existence of the advantage is first taught in the present application. Thus, the rejection of claim 24 under §103 is without basis and should be withdrawn.

It is noted that the Examiner has suggested the use of a

U.S. SN 09/554 674
October 14, 2003
Page 14

Declaration to overcome the Froessl reference. While it is true that the 5,875,263 patent was invented by the same individual inventive entity as the present application, and that the patent and the present application are commonly owned by that same inventor, the patent is directed to quite different subject matter from the present application and there is no real connection other than inventorship. A Declaration therefore seems inappropriate or, at least, unnecessary.

Claims 25 and 26 were also rejected as being unpatentable under §103(a) over Smith in view of Froessl further in view of Tabuchi. Tabuchi is cited as showing a reviewing step which includes searching through stored information and selecting parts of documents which have been used more than a preselected number of times as being content repeatedly used and identifying such selected parts by an access code. Several portions of the text and drawings of Tabuchi were cited as supporting this proposition. A careful review of these and other parts of Tabuchi reveals no such teaching.

Tabuchi teaches a system in which parts of document are stored with individual access codes and are made available (visible) in different combinations to a plurality of clients. These clients are able to select and combine document parts from the choices presented to them to form a finished document. However, there is no teaching of reviewing or searching through stored information to determine how many times various parts have been used or choosing ones which have been used a predetermined number of times. Accordingly, Tabuchi does not show that for which it was cited. The rejection of claims 25 and 26 based thereon is without merit and should be withdrawn.

Claims 27 through 48 were also rejected in ¶18 of the Action, with claim 24, as being unpatentable over the combination

U.S. SN 09/554 674
October 14, 2003
Page 15

of Smith with Froessl.

Claims 27 and 28 are dependent on claim 24 and should be allowable therewith for the reasons discussed above.

Claim 29 is independent but also includes language which clearly distinguishes the claim from the teachings of Smith and/or Froessl. Specifically, claim 29 recites reviewing automatically and in a learning mode the content of the output documents to identify parts thereof that are repeatedly used amongst such documents, generating automatically a storage access code uniquely associated with such identified document parts and adding the identified document parts, each with its uniquely associated storage access code, to the stored data comprising parts of documents to be compiled, compiling and storing output documents of selected format and content and designated unique data by substituting in response to requests from clients the storage access codes of the document parts identified in and by document output compilation requests from clients, and transmitting the output documents to a recipient service center, thereby reducing unique data to be added to output documents.

Neither Smith nor the cited Froessl patent includes a teaching of a learning mode meeting the requirements of this language. Accordingly, claim 29 should be allowable.

Claims 30 and 31 include language such as "repeatedly and automatically reviewing the text of output documents stored for a client to identify phrases repeatedly used by that client and which are not part of the stored data, and adding the identified phrases to the data comprising parts of documents to be generated, thereby reducing unique data to be added to output documents". This language is in combination with other features of the system. As pointed out above, a teaching of this aspect of the invention is nowhere taught by Froessl or Smith, alone or

U.S. SN 09/554 674
October 14, 2003
Page 16

in any proper combination, and claims 30 and 31 should therefore be allowable.

Claims 32 through 48 are all ultimately dependent on claim 31 and should therefore be allowable therewith. While these claims may also include other distinguishing features, they are allowable whether or not that is true and it does not appear to be necessary to discuss such features separately.

In the rejection of claim 41 (¶77 and ¶78 of the Action), mention was also made of col. 6, lines 1-46 of Froessl for its showing of electronically marking the generated document. Although claim 41 is allowable for the reasons given in the above paragraph, mention should be made of the other teachings included in this portion of the Froessl patent.

Col. 6, lines 1-46 describes an important feature of the invention claimed in that patent in which the system can look for a logo by image searching. This can be done by searching the top two or three inches of the incoming document. If such a logo is found, a comparison can be made to see if the sender's logo matches a logo previously encountered and stored by the system. If so, this recognition can facilitate identification of a font commonly used by the sender, one which may be used in the present document. If not, the new information is stored.

While this process clearly involves a step of automatically looking for a font, it clearly does not teach a learning step such as that claimed in claim 31 on which claim 41 depends, i.e., "repeatedly and automatically reviewing the text of output documents stored for a client to identify phrases repeatedly used by that client and which are not part of the stored data, and adding the identified phrases to the data comprising parts of documents to be generated, thereby reducing unique data to be added to output documents". Thus, as previously argued, claim

U.S. SN 09/554 674
October 14, 2003
Page 17

41, as well as the other claims involving this step, clearly and patentably distinguish over the cited references.

Claim 49 has been canceled.

Claims 50 and 51 were rejected as being anticipated by Smith. However, claim 50, among other features, recites repeatedly and automatically reviewing the text of output documents stored for a client to identify phrases repeatedly used by that client and which are not part of the stored data, and adding the identified phrases to the data comprising parts of documents to be generated, thereby reducing unique data to be added to output documents. It was acknowledged in the Action (with reference to other claims, ¶¶23 and 24 of the Action and elsewhere) that this feature is not shown by Smith. Furthermore, as pointed out above, this feature is not taught by Froessl. Accordingly, the rejection on this basis of claim 50 is clearly in error and should be withdrawn.

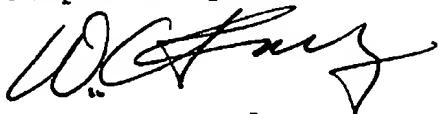
Claim 51 is dependent on claim 50 and should be allowable therewith.

Claims 52 and 53 were separately rejected as being unpatentable over Smith in view of Perry which was cited as showing means for storing and printing documents for sale. However, claims 52 and 53 are dependent on claim 50 which, as described above is allowable as including repeatedly and automatically reviewing the text of output documents stored for a client to identify phrases repeatedly used by that client and which are not part of the stored data, and adding the identified phrases to the data comprising parts of documents to be generated, thereby reducing unique data to be added to output documents. Perry does not show any such feature, nor does any other reference cited and relied upon in the Action. Since claims 52 and 53 are dependent on claim 50, they should be

U.S. SN 09/554 674
October 14, 2003
Page 18

allowable therewith, regardless of whatever storing and printing
features are shown in Perry.

Respectfully submitted,



Walter C. Farley
Reg. No. 22,624
Attorney for Applicant

P.O. Box 329
Harpswell ME 04079
Fax 207 833 7831
Tel 207 833 6793